

Remarks

New drawings are required. Claims 1, 3, 5, 8-10, 23, 26, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) in view of Lo (US 5,699,083). Claims 2, 4, 6, 7, 18-20, 24-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) in view of Merminod et al. (US 6,157,369). Claims 11, 13-15, 21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) in view of Fisher (US 5,903,267). Claims 16-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) and Merminod et al. (US 6,157,369) in view of Gentner et al. (US 6,271,838).

1. New drawings required:

15 New corrected drawings are required in this application because the drawings are very small; Examiner cannot see the elements of the drawings.

Response:

20 A new copy of the drawings is enclosed with this response to the Office action. A total of seven pages of drawings are enclosed, having figures 1 to 9 thereon. The applicant believes that the drawings were inadvertently shrunk through complications with electronic filing, and requests acceptance of the newly submitted copies.

25 2. Rejection of claims 1, 3, 5, 8-10, 23, 26, 28, and 30 under 35 U.S.C. 103(a):

Claims 1, 3, 5, 8-10, 23, 26, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) in view of Lo (US 5,699,083) for reasons recited on pages 2-4 of the above-indicated Office action (part of paper no.6).

30

Response:

The applicant wishes to point out the differences between prior art patents

Faltermeier et al. (hereinafter Faltermeier) and Lo and the present invention according to claims 1 and 23.

Claim 1 of the instant application claims a pointing device connected to a computer. The pointing device a light source for illuminating a rollable device and a control unit for controlling the pointing device. Please note that the control unit is a component of the pointing device, and is not the same thing as the pointing device. When the computer transmits a state signal to the pointing device, the control unit controls the light source to illuminate the rollable device according to the state signal.

Faltermeier, on the other hand, uses the term “control unit” to have the same meaning as the applicant’s term “pointing device”. This is seen in the abstract of Faltermeier, where a “one-hand control unit” is said to correspond essentially to a computer mouse. Moreover, Faltermeier does not teach or suggest that a control unit of a pointing device is used to control a light source of the pointing device to illuminate a rollable device according to a state signal from a computer.

Likewise, **Lo** only discloses a wheel 17 illuminated by a light source 29. Lo does not disclose a control unit that controls a light source to illuminate a rollable device according to a state signal from a computer. Therefore, the present invention according to claim 1 is not unpatentable over Faltermeier in view of Lo.

Claim 23 has been amended to overcome this rejection. The limitations of claim 25 have been merged into claim 23 and claim 25 has been subsequently cancelled. Claim 23 states that a light source is used for illuminating a rolling wheel. The rolling wheel comprises a roller and a ring, in which the ring surrounds an outer circumference of the roller and is adapted to let a user rolling the rolling wheel contact the ring.

On the other hand, Merminod et al. (hereinafter Merminod) shows in Fig.2 and Fig.3 (and in col.3, lines 18-21) a ring 40 positioned on an inside circumference of a roller 12, not on the outside. Therefore, the structure taught by Merminod is not adapted to let a user contact the ring 40 for rolling the roller 12.

5 For these reasons, the applicant submits that the present invention according to the currently amended claim 23 is not unpatentable over Faltermeier and Lo in view of Merminod.

10 Claims 3, 5, and 8-10 are dependent on claim 1 and should be allowed if claim 1 is allowed. Similarly, claims 26, 28, and 30 are dependent on claim 23 and should be allowed if claim 26 is allowed. Reconsideration of claims 1, 3, 5, 8-10, 23, 26, 28, and 30 is politely requested.

3. Rejection of claims 2, 4, 6, 7, 18-20, 24-25, and 29 under 35 U.S.C. 103(a):

15 Claims 2, 4, 6, 7, 18-20, 24-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) in view of Merminod et al. (US 6,157,369) for reasons recited on pages 5-6 of the above-indicated Office action (part of paper no.6).

20 **Response:**

As with the currently amended claim 23, claim 4 also contains the limitations of the rolling wheel comprising:

25 “a roller and a ring, the ring surrounding an outer circumference of the roller and adapted to enable a user to roll the rolling wheel while contacting the ring, the ring being made of a transparent material to allow the light provided by the light source to pass through the ring.”

Therefore, claim 4 is not unpatentable over Faltermeier and Lo in view of
30 Merminod.

In addition, claims 2, 4, 6, 7, and 18-20 are dependent on claim 1, and

should be allowed if claim 1 is allowed. Similarly, claims 24 and 29 are both dependent on claim 23 and should be allowed if claim 23 is allowed.
Reconsideration of claims 2, 4, 6, 7, 18-20, 24, and 29 is politely requested.

5 4. Rejection of claims 11, 13-15, 21, and 27 under 35 U.S.C. 103(a):

Claims 11, 13-15, 21, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) in view of Fisher (US 5,903,267) for reasons recited on pages 6-7 of the above-indicated Office action (part of paper no.6).

10

Response:

Claims 11, 13-15, and 21 are dependent on claim 1, and should be allowed if claim 1 is allowed. Similarly, claim 27 is dependent on claim 23 and should be allowed if claim 23 is allowed. Reconsideration of claims 11, 13-15, 21, and 27 is politely requested.

15 5. Rejection of claims 16-17 and 22 under 35 U.S.C. 103(a):

Claims 16-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faltermeier et al. (US 5,712,725) and Lo (US 5,699,083) and Merminod et al. (US 6,157,369) in view of Gentner et al. (US 6,271,838) for reasons recited on pages 7-8 of the above-indicated Office action (part of paper no.6).

20 **Response:**

Claims 16-17 and 22 are dependent on claim 1, and should be allowed if claim 1 is allowed. Reconsideration of claims 16-17 and 22 is politely requested.

25 30

Respectfully submitted,

5 Winston Hsu Date: 12/23/2003

Winston Hsu, Patent Agent No.41,526

P.O. BOX 506

Merrifield, VA 22116

U.S.A.

10 e-mail: winstonhsu@naipo.com.tw

(Please contact me by e-mail if you need a telephone communication and I will return your call promptly.)